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UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,952	09/26/2001	Toshihide Hida	1122.65856	1582

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EXAMINER
VAN DOREN, BETH

ART UNIT	PAPER NUMBER
3623	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	09/963,952	HIDA, TOSHIHIDE
	Examiner	Art Unit	
	Beth Van Doren	3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>23 March 2007</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>7-9,13-15,19-21 and 25-27</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>7-9,13-15,19-21 and 25-27</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   The following is a non-final office action in response to communications received 03/23/07. Claims 10-11, 16-17, and 22-23 have been canceled. Claims 7, 13, and 19 have been amended. Claims 7-9, 13-15, 19-21, and 25-27 are now pending in this application.

Response to Arguments

2.   Examiner notes that this non-final office action was issued to correct a dependency error made with respect to claim 26. In both the prior action and in the current action, she relies on Bilbrey et al. to teach this claim.

3.   Applicant's arguments with regards to rejections based on Bilbrey et al. (U.S. 2002/0103932) have been fully considered, but they are not persuasive. In the remarks, Applicant argues that Bilbrey et al. does not teach or suggest (1) determining from a plurality of provided message address lists of message exchanging groups, a message address list including old addresses of the member and extracting message addresses of the rest of the members of the determined message address list, wherein the rest of the members include members with message addresses that have not changed, and (2) means for determining a server associated with each of the rest of the members of the determined address list, means for specifying a server or servers to which absence response information is to be provided, on the basis of the determined server or servers, and means for distributing the absence information to the specified server or servers.

In response to argument (1), Examiner respectfully disagrees. The lists of Bilbrey et al. contain members whose addresses have changed and members whose addresses have not changed. An address list is communicated and used to substantially update the "sponsors" email address list. Email addresses are received and matched against old email addresses. The members that are not the member whose address is changing are obtained and the member and

other members in the list with old addresses are obtained and updated. See paragraphs 55, 58,

61, 63-4, 68, 80, 85-9. therefore, the two groups of updates and non-updates are separated by the

system, and thus teach extracting the rest of the members of the determined message address list,

wherein the rest of the members include members with message addresses that have not changed.

In response to argument (2), Examiner respectfully disagrees. Examiner notes that the

claim states determining a server, and therefore only one server is required. The limitations that

follow recite a server or servers, so again, only one server is required by the system. Bilbrey

teaches sending the absence response information to a server and updating the appropriate

databases based upon where the request originated from, as discussed in at least paragraph 55.

See also paragraphs 7-8, 47, 59, and 85-9, where the network server has information concerning

address changes, and the "sponsor" interacts with this server based on the information contained

in its list. That specific sponsor is therefore the "specified" server to receive the absence

information. See also paragraphs 10, 46, and 59, which specifically state that the user can

specify sponsor servers, which are and are not allowed to receive the address updates. Examiner

notes that claims 7, 13, and 19 merely recite "specifying a server", but does not specifically

recite what this entails. Therefore, in the broadest reasonable interpretation of this limitation,

specifying could mean that the user restricts the servers that can receive the address, but could

also mean that the servers that query for address updates are specified (i.e. identified or

indicated) to receive the information (such as a request is identified to receive an answer). As

per Applicant's comments on page 9, Bilbrey et al. does not automatically provide information to

all servers (supported by paragraphs 10, 46, and 59).

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5.   Claims 7-9, 13-15, 19-21, and 25-27 are rejected under 35 U.S.C. 102(e) as being

anticipated by Bilbrey et al. (U.S. 2002/0103932).

As per claim 7, Bilbrey et al. teaches a computer readable medium storing a program to

cause a computer to perform message-address management processing in a system capable of

exchanging messages among a plurality of servers and clients, wherein the program causes a

server computer to perform:

when a message address of a member of a message exchanging group is changed,

absence response information including at least an old address and a new address of the member

is caused to be received from the client (See paragraph 83, where updates of a recipient's address

is provided. See also paragraphs 7-8, 10, 46-7, and 63-4, where a member of a group of

recipients in a message system changes his/her address and this information is sent by the client

to the server. See also figures 20-21, where a recipient specifies his old and new address as well

as with whom this information can be shared);

determining, from a plurality of provided message address lists, lists of message

exchange groups, a message address list including the old address of the member, and extracting

message addresses of the rest of the members of the determined message address list, wherein

the rest of the members includes members with message addresses that have not been changed

(See paragraphs 58, 80, 85-9, wherein an address list is communicated and used to substantially

update the "sponsors" email address list. Email addresses are received and matched against old

email addresses. The members that are not the member whose address is changing are obtained

and the member along with other members in the list with old addresses are obtained, and

updated. See also paragraphs 55, 61, 63-4, 68);

determining a server associated with each of the rest of the members of the

determined message list (See abstract, paragraphs 7, 82, and 112, wherein members

are associated with a server which is located for address changes and notifications.

See also paragraphs 8, 10, 46-7, 55, 59, and 85-9, where the network server has information

concerning addresses and the "sponsor" interacts with this server based on the information

contained in its list);

specifying a server to which the absence response information is to be provided, on the

basis of the determined server or servers (See paragraphs 7-8, 10, 46-7, 55, 59, and 85-9, where

the network server has information concerning address changes, and the "sponsor" interacts with

this server based on the information contained in its list); and

distributing the absence response information to the specified server or servers (See

paragraphs 7, 55, 59, wherein the network server and the sponsor communicate to provide and

receive the information).

As per claim 8, Bilbrey et al. discloses wherein the absence response information

contains a period of validity of the absence response information (See paragraphs 112 and Table

3, where the determination is made as to whether addresses are valid. See also paragraphs 61

and 68, wherein the address information is time stamped, to show the time at which the date

become valid and up to date).

As per claim 9, Bilbrey et al. teaches wherein a plurality of pieces of the absence

response information to be distributed to the same server are gathered together for distribution

See paragraph 58, wherein the information to be distributed to the sponsor is gathered together at

the server for distribution to the sponsor based on the list and the Reconnection Manager).

Claims 13-15 recite substantially similar subject matter to claims 7-9, respectively, and

are therefore rejected using the same art and rationale set forth above.

Claims 19-21 recite substantially similar subject matter to claims 7-9, respectively, and

are therefore rejected using the same art and rationale set forth above.

As per claims 25-27, Bilbrey et al. discloses wherein absence response information

includes a flag indicating whether the absence response information is to be provided to a mail

server administrator (See paragraph 0080, wherein an indication is sent by an administrator to

receive absence information (i.e. undeliverable addresses and/or all addresses)).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

Tornabene et al. (U.S. 2002/0023132) teaches a shared group system and maintaining

universal addresses that can be updated.

. Dixon et al. (U.S. 2002/0007421) discloses an address system and updating addresses to

new addresses.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beth Van Doren whose telephone number is 571-272-6737. The examiner can normally be reached on M-F, 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 571-272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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June 4, 2007

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